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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/305,146	05/04/1999	GEORGE V. GUYAN	AND1P069	1663

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/305,146

Applicant(s)

GUYAN ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 and 41-67 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22, 41-67 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22 and 41-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 22: claim 22 has been amended to refer to “responsibilities of said system”, and includes the negative limitation of “wherein said responsibilities do not include functions performed by said event processor”. This negative limitation is new matter, since it not disclosed in the original specification.

MPEP 2173.05(i) states: “Any negative limitation or exclusionary proviso must have basis in the original disclosure.” It further states: “The mere absence of a positive recitation is not a basis for an exclusion.”

It has been determined that: (1) The negative limitation of system responsibilities not including functions performed by the event processor is a requirement which is not anywhere supported in the original specification; (2) The requirement cannot be supported by the mere absence of the recitation in the specification.

Applicant also does not assert that the amendment is lacking in new matter and does not point to where the feature is recited in the specification, which further supports the finding of new matter.

Claims 41-65: Depend on claim 22.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 66-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Borghesi et al. (U.S. Patent 5,950,169).

Claim 66: FIG.3 of Borghesi et al. discloses event processors (30 or 32 or 34) which interact with a data component (a claim folder, FIG. 6). The event processor identifies data events (information about vehicle accidents) by creating data files on vehicle accidents. As seen in FIG. 8E, the event processor can determine a response (send data) and follow programming steps to identify system components (programs 200-218) that can process the claims using the received data.

The task engine application program is any one of the programming sets (200-218—FIG. 8E) of the computers (30, 32, 34—FIG. 3) which process some aspect of the insurance claim.

FIG.6 illustrates one of the data components residing in the claim file. The claim folder is decomposed into a plurality of levels, such as “assignment”, “inspection”, “policy”, “parties”, “statements”, “loss” and “repair site”. The policy level is at the tab marked “policy”. The claim level is at the tab marked “loss”. The participant level is at the tab marked “parties”. The line level is at the higher level tab marked “totals”.

FIG. 6 illustrates the claim folder is displayed via a user interactive interface (a graphical user interface). Any one of the users at the computers (30 or 32 or 34) can interact with the levels of the claim folder to retrieve data of the folder and enter data into the folder.

Referring back to FIG. 8E, the event processor can direct data to one of the components (202) which becomes the task engine that can create a list of actions to be taken (FIG. 8F, 220-230).

Claim 67: See remarks for claim 66.

Remarks

Applicant's amendments to claim 22 have overcome the rejection under 35 USC 112, second paragraph for indefiniteness, but have raised a new ground of rejection under 35 USC 112, first paragraph for new matter. The detailed discussion for this rejection is provided above.

Claims 66-67 have been rejected under 35 USC 102(e) as being anticipated by Borghesi et al., and this rejection is sustained. Applicant first argues that the system of Borghesi does not permit two users to simultaneously access a claim folder. This argument is not correct. As seen in FIGS. 2-3, the claims folder are located in a central repository and accessible to clients (30, 32, 34) via central server (36). As in any client-server configuration, access to data by the client does not lock out access to that data by the other clients. Any one of the clients can simultaneously access the claim folders, much in the same way that many clients can access a single web page via servers within the Internet. Borghesi et al. does not suggest that access to one folder by one client "locks out" all other access by all other clients.

Applicant also argues that Borghesi does not disclose the automatic generation of a list of tasks. This argument is not correct, FIGS. 8E through 8F illustrate that when a user selects the

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“create/edit” data function in FIG. 8E, this selection automatically generates a series of tasks that have to be performed according to the sequence defined in FIG. 8F. These steps are triggered by a determination of claim characteristics, such as defined by step 202. Step 220 can also be read as the identification of a claim characteristic. Identifying the characteristic then automatically triggers the generation of tasks, according to the define flow chart in FIG. 8F. This list of tasks is not suggested as being triggered manually or randomly, since the flow chart of FIG. 8F defines both the tasks themselves and the exact sequence in which they must be followed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell
Primary Examiner
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